

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Yoshifusa TOGAWA et al.

Serial No. 09/225,208

Group Art Unit: 3691

Confirmation No. 2746

Filed: January 4, 1999

Examiner: Siegfried E. CHENCINSKI

For: SYSTEM FOR MANAGING RESOURCES USED AMONG GROUPS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Attention: **MAIL STOP AF**
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

This is a "pre-appeal brief request for review" filed concurrently with a Notice of Appeal appealing final rejection of claims 1-2 and 4-26 in the November 15, 2007 final Office Action (FOA). A Petition for a Third Month Extension of Time, together with the requisite fee, is enclosed thereby extending the response due date to May 15, 2008.

Claims 1-2 and 4-26 are pending. The independent claims are 1, 21, and 24. Claims 1, 5, 21 and 24, which include independent claim 1, 21 and 24, are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Fargher (U.S. Patent No. 5,826,040), in view of Matsuzaki (U.S. Patent No. 5,767,848). Dependent claims are rejected as indicated in the FOA.

A pre-appeal brief panel review of below appealable issues I and II is requested:

I. The Office Action rejection of independent claims 1, 21 and 24 over Fargher and Matsuzaki is clearly improper, because the Office Action errs by improperly alleging the claim language merely describes intended use (FOA page 3) and failing to give patentable weight to the claim language "each job definition form defining worker groups, job procedures for the worker groups, job-object conditions, and resources, said resources including job objects, available to the worker groups for processing the objects of the object-oriented system as the job objects according to the job procedures and the job-object conditions." Because the Office Action does not give patentable weight to the claimed structural limitations of the "job definition form ...", the Office Action improperly alleges the claims are directed to any job form (FOA page 4) and alleges a prima facie case of obviousness has been established based upon the *KSR Int'l*

Co. v. Teleflex Inc. 127 S.Ct. 1727, 82 USPQ 2d 1385 (2007) decision that common sense is a legitimate factor in the prosecution of the claims (FOA Response to Arguments).

MPEP 2106-II-C discusses claims terms that limit scope vs. intended use terms that might not limit scope of claims, and provides:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP §2111.04.

MPEP 2111.04 discusses intended use claim language in the context of claim preambles:

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim."

The language of claim 1 expressly provides structural limitations of a "job definition form" by clearly reciting "each job definition form defining worker groups, job procedures for the worker groups, job-object conditions, and resources, said resources including job objects, available to the worker groups ..." Further, the claim language "resources including job objects ... for processing the objects of the object-oriented system as the job objects according to the job procedures and the job-object conditions," further limits the phrase "resources." In other words, the language of the claims define the structure of a job definition form according to the inventive concept, which limits the scope of the claimed job definition form vs. other job definition forms. FIG. 9 (page 16, lines 14-30) and FIG. 36 (page 27, lines 14-18) support the claims. In FIG. 9, "GROUP A (JOB A1): resource [window1, ... , windowk], [object1, ..., objectL], [data1, ..., dataM]" provides an example of the claimed structural limitations of a job definition form.

Once the claims are properly given patentable weight, the Office Action's rejection over Fargher and Matsuzaki is clearly improper, because Fargher is silent on any forms that contain the claimed structural limitations of a job definition form. In fact, the Office Action acknowledges Fargher does not discuss job forms. The Office Action page 4 relies upon Matsuzaki columns 17-20 for job forms, however, Matsuzaki's FIG. 16 shows a form for development progress of a component part, namely Matsuzaki's job forms in FIGS. 16 and 21 are 'condition of progress' and 'progress management' forms, which do not show, for example, who is working on the product being developed. The claimed structural limitations of the job definition form are clearly not met by Matsuzaki's forms in FIGS. 16 and 21.

The Office Action has not properly established a prima case of obviousness, because the Office Action omits any line of reasoning of how the claimed structural limitations of the job definition form are met by Matsuzaki, but the Office Action page 4 in conclusory paragraph alleges one skilled in the art would create a general job definition form, because formatted information presentation would be beneficial. In other words, the Office Action does not provide any evidence either expressly or implicitly that one skilled in the art would combine Matsuzaki's forms for development progress of a component part with Fargher and then modify Matsuzaki's forms to provide the claimed structural limitations of the job definition form.

A benefit of the claimed embodiments is that the job definition form enables efficient job management based upon worker groups by worker groups or from perspective of worker groups, rather than the conventional way of managing jobs from perspective of a job, by efficiently enabling movement of workers among the worker groups and managing security of the job objects on a worker group by worker group/member by member basis. See dependent claims 4, 5, 6, 11, 12, and 13.

Regarding the Office Action Response to Arguments that KSR allows applying common sense to reject the claims, it is respectfully submitted that MPEP 2141 guidelines for determining obviousness in view of KSR expressly provide mere conclusory statements are not permitted, namely the Office Action cannot withhold patentable weight to parts of claim language and then declare common sense supports rejecting the claims over Matsuzaki that is silent on the claimed structural limitations of the job definition form. It is submitted, the Office Action has not provided any evidence expressly or implicitly to support the MPEP obviousness rationales MPEP 2141-III-(A) through (G). Previous Amendment of July 26, 2008 expressly addressed the obviousness rejection rationale A-G, which are not repeated here in the interest of compactness and in view of Pre-Appeal Brief Pilot Program OG Notice of July 12, 2005 guidance. In particular, the

Applicants have asserted that all of the elements of the claims are not known in the prior art, because the Office Action acknowledges Fargher does not disclose the claimed job definition form elements, and Matsuzaki's job forms in FIGS. 16 and 21 are 'condition of progress' and 'progress management' forms, which do not show, for example, who is working on the product being developed. In fact, none of the other nine prior art references relied upon by the Examiner disclose expressly or implicitly the concept of providing a job definition form having the claimed structural limitations, providing a benefit of managing jobs on a worker group basis rather than on a job basis (see also MPEP 707.07(g) undue multiplication of references).

However, the final Office Action maintained not giving patentable weight to claim language and asserted common sense to reject the claims, which is not part of USPTO obviousness rejection rationale policy/guidelines. While KSR and MPEP 2141.I discuss that source of what a person of ordinary skill in the pertinent art would have known at the time of the invention can be common sense, MPEP does not authorize the Office to apply KSR common sense based rejections per se, as that would directly conflict the Office's policy to provide documentary evidence in support of rejection rationale (MPEP 2144.03.A "It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. ... As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support").

By relying on common sense per se, the Office Action is constructively taking Official Notice of facts not in the record in making the rejection, which MPEP 2144.03 requires the Examiner to provide documentary evidence. Further, the Office Action does not provide any line of reasoning supporting the rejection of the claimed structural limitations of the job definition form by being within purview of common sense per se, other than the conclusory paragraph in page 4 that one skilled in the art would create a general job definition form, because formatted information presentation would be beneficial, without any line of reasoning regarding the claimed structural limitations of "worker groups" and "job procedures for the worker groups," "job object conditions" and "resources, said resources including job objects, available to the worker groups for processing the objects of the object-oriented system as the job objects according to the job procedures and the job-object conditions." The Office Action page 4 alleges "use of forms of all kinds ... are an ever present component of life in every facet of business activity," however, the language of the claims does not merely recite a "job form" per se, but a job form having the recited structural limitations. Further, it is submitted that all of the elements of the claims are not

known in the prior art, so KSR common sense based rejection rationale is not applicable to the present claims, or in other words the claims do not fall under the example obviousness rejection rationales A-F in MPEP 2141.III, because the Office Action acknowledges Fargher does not disclose the structural limitations of the claimed job definition form, and Matsuzaki only discloses job forms in FIGS. 16 and 21 that are 'condition of progress' and 'progress management' forms, which do not show, for example, who is working on the product being developed.

II. The Office Action rejection of independent claims 1, 21 and 24 over Fargher and Matsuzaki is clearly improper, because the Office Action errs by improperly failing to give patentable weight to the emphasized claim language "a rearranger managing worker rearrangements among the worker groups and managing the job-object conditions of the rearranged worker groups according to a progress of the jobs from the job monitor based upon the procedure of each worker group in the job definition form, ***wherein said job monitor monitors the job processing and the job objects of the worker groups according to information from said rearranger.***" However, the language of the claim is not merely intended use, because it clearly limits an operation of the job monitor to monitoring the job processing and the job objects of the worker groups based upon the rearranger.

The Office Action also relies on Fargher columns 9-10 and Matsuzaki column 14. Fargher column 9-10 does not discuss rearranging of workers among worker groups based upon job progress. Matsuzaki discusses a member assigned to each activity unit may be changed. An activity unit is a job and differs from a worker group. FIGS. 12, 14 and page 8, line 36 to page 9, line 9; and page 18, line 18 to page 19, line 35 support the claims.

The final Office Action rejections are clearly improper, because the Examiner errs by not giving patentable weight the language of the claims, and thus clearly failing to establish a prima facie case of obviousness based upon the prior art of Fargher and Matsuzaki.

Withdrawal of the rejection of pending claims is respectfully requested. If there are additional fees associated with this filing, please charge same to Deposit Account No. 19-3935.

Respectfully submitted,
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